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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,778	10/23/2003	Jerry A. Pickering	10167	7165

7590 04/02/2007
MARK G. BOCCHETTI
EASTMAN KODAK COMPANY
343 STATE STREET
RODCHESTER, NY 14650

EXAMINER

AFZALI, SARANG

ART UNIT	PAPER NUMBER
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3726

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/691,778

Applicant(s)

PICKERING ET AL.

Examiner

Sarang Afzali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed 1/19/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 1-63, 67, 68, 72-79, 82-85 and 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 64-66, 69-71, 80, 81, 86 and 87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The applicant's amendment filed on 1/19/2007 has been fully considered and made of record.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 64-71 are rejected 35 U.S.C. 103(a) as being unpatentable over Eddy et al. (US 5,729,813).

Eddy et al. teach a fuser member comprising a base 6; and a fusing surface layer 2; comprising: a fluoroelastomer (col. 18, line 6); and filler particles (col. 18, line 6), with a modulus greater than the modulus of the fluoroelastomer (Modulus is a measure of stiffness of a given material. The filler is made of alumina, which has a modulus greater than a fluoroelastomer which is not as stiff. In addition, the filler imparts hardness to the layer as described in col. 7, lines 52-56, therefore, the filler is harder or stiffer than the fluoroelastomer.) at the fusing temperature, and with a mean particle diameter of at least about 8 microns (col. 7, line 60), in at least the minimum proportion by volume of the fusing surface layer, and with at least the minimum mean particle diameter.

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Regarding the limitations "so that, in fusing toner to substrate, the fuser member generates an image having a gloss number of about 5 or less" and "in fusing toner to substrate, the fuser member, at the equilibrium surface roughness, generates an image having a gloss number of about 5 or less", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The filler particles are heat conducting and have a greater thermal conductivity than the fluoroelastomer because the filler is made of alumina. In addition, alumina is considered inorganic.

Eddy et al. teach the invention cited above with the exception of having a mean particle diameter of at least 50 microns as in recited claims 64-66 or a mean particle diameter greater than about 55 microns as recited in claim 70.

At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have used a mean particle diameter of at least about 50 microns as recited in claims 64-66 or a mean particle diameter greater than about 55 microns as recited in claim 70 because applicant has not disclosed that a mean particle diameter from about 50 as recited in claims 64-66 or a mean particle diameter greater than about 55 microns as recited in claim 70 provides an advantage, is used for a particular purpose, or solves a stated problem.

One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the mean particle diameter taught by Eddy

et al. or the claimed mean particle diameter because either particle diameter perform the same function of providing conductivity equally well.

In addition, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to modify the particle size depending upon the desired conductivity needed for the roll.

4. Claims 80, 81, 85, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al. in view of Donnelley et al. (US 3,669,707).

Eddy et al. teach the invention cited above with the exception of using plastic filler particles such as polytetrafluoroethylene. Donnelley et al. teach using plastic filler particles such as polytetrafluoroethylene (col. 4, line 66). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Eddy et al. with plastic filler particles such as polytetrafluoroethylene, in light of the teachings of Donnelley et al., in order to reduce offset and mechanical breakdown as suggested by Donnelley et al.

Response to Arguments

5. Applicant's arguments filed 1/19/2007 have been fully considered but they are not persuasive.

Applicant's amendment to claims 69, 70, 86, and 87 to overcome the rejection under 35 USC 112, second paragraph for indefiniteness is accepted and therefore, the

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rejection of claims 69, 70, 86, and 87 under 35 USC 112, second paragraph is withdrawn.

Under "Remarks", pages 1-2, with respect to Eddy et al., applicant argues that since Eddy et al. limits the size of the filler particles to 15 microns (col. 7, line 60) which is much less than 50 microns, Eddy does not show every element of Applicant's claims and that Donnelley does not cure the deficiencies of Eddy and therefore, both rejections under 102 (b) and 103(a) should be withdrawn.

The Examiner respectfully disagrees with the above arguments. Note that applicant originally claimed (claim 64, filed 7/24/2006) a "mean particle diameter of at least about 8 microns" for the filler particles, which indicates that Applicant's invention would have performed equally well with that particle size. However, Applicant is now introducing a different particle size (50 microns) only to overcome Eddy and not because any other particle sizes (i.e. 8 or 15 or 20 microns) are not suitable for adequate performance.

Therefore, the Examiner considers that it is within the skill level of one of ordinary skill in the art to have used any suitable particle size depending upon the desired conductivity needed for the roll.

As for Donnelley et al., this reference is only relied upon to teach plastic filler particles, which Eddy was lacking.

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Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarang Afzali whose telephone number is 571-272-8412. The examiner can normally be reached on 7:00-3:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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3/26/2007



DAVID P. BRYANT
SUPERVISORY PATENT EXAMINER

3/26/07